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OFFICE OF PETITIONS

In re Application of

McCloy, et al.

Application No. 09/495,105

Filed: 1 February, 2000

Attorney Docket No.: BRI.00026

: ON PETITION
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This is a decision on the petition filed 23 July, 2002, under 37 C.F.R. §1.183¹ requesting that the Office waive the timing requirements of 37 C.F.R. §1.193,² which sets forth the period within

¹ The regulations at 37 C.F.R. §1.183 provide, in pertinent part:
§1.183 Suspension of the Rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. * * *

² The regulations at 37 C.F.R. §1.193 provide:
§1.193 Examiner's answer and reply brief.

(a)(1) The primary examiner may, within such time as may be directed by the Commissioner, furnish a written statement in answer to appellant's brief including such explanation of the invention claimed and of the references and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner finds that the appeal is not regular in form or does not relate to an appealable action, the primary examiner shall so state.

(2) An examiner's answer must not include a new ground of rejection, but if an amendment under §1.116 proposes to add or amend one or more claims and appellant was advised that the amendment under §1.116 would be entered for purposes of appeal and which individual rejection(s) set forth in the action from which the appeal was taken would be used to reject the added or amended claim(s), then the appeal brief must address the rejection(s) of the claim(s) added or amended by the amendment under §1.116 as appellant was so advised and the examiner's answer may include the rejection(s) of the claim(s) added or amended by the amendment under §1.116 as appellant was so advised. The filing of an amendment under §1.116 which is entered for purposes of appeal represents appellant's consent that when so advised any appeal proceed on those claim(s) added or amended by the amendment under §1.116 subject to any rejection set forth in the action from which the appeal was taken.

(b)(1) Appellant may file a reply brief to an examiner's answer or a supplemental examiner's answer within two months from the date of such examiner's answer or supplemental examiner's answer. See §1.136(b) for extensions of time for filing a reply brief in a patent application and §1.550(c) for extensions of time for filing a reply brief in a reexamination proceeding. The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

(2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

(i) File a reply under §1.111, if the Office action is not final, or a reply under §1.113, if the Office action is final; or

(ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§1.130, 1.131 or 1.132) or other evidence are permitted.

[24 Fed. Reg. 10332, Dec. 22, 1959; 34 Fed. Reg. 18858, Nov. 26, 1969; para. (c), 47 Fed. Reg. 21752, May 19, 1982, added effective July 1, 1982; para. (b), 50 Fed. Reg. 9382, Mar. 7, 1985, effective May 8, 1985; 53 Fed. Reg. 23735, June 23, 1988, effective Sept. 12, 1988; para. © deleted, 57 Fed. Reg. 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (b) revised, 58 Fed. Reg. 54504, Oct. 22, 1993, effective Jan. 3, 1994; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (b)(1) revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000]

which a reply brief must be filed, as limited by the regulations at ¶(b) of 37 C.F.R. §1.136.³

The Office regrets the delay in addressing this matter.

The petition regarding suspension of the rules under 37 C.F.R. §1.183 as to delays for filing the Reply Brief is **DISMISSED**.

Any request (and fee) for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.183."

BACKGROUND

The record indicates that:

³ The regulations at 37 C.F.R. §1.136 provide:

§1.136 Extensions of time.

(a)(1) If an applicant is required to reply within a nonstatutory or shortened statutory time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set in § 1.17(a) are filed, unless:

- (i) Applicant is notified otherwise in an Office action;
- (ii) The reply is a reply brief submitted pursuant to § 1.193(b);
- (iii) The reply is a request for an oral hearing submitted pursuant to § 1.194(b);
- (iv) The reply is to a decision by the Board of Patent Appeals and Interferences pursuant to § 1.196, §1.197 or §1.304; or
- (v) The application is involved in an interference declared pursuant to § 1.611.

(2) The date on which the petition and the fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The expiration of the time period is determined by the amount of the fee paid. A reply must be filed prior to the expiration of the period of extension to avoid abandonment of the application (§ 1.135), but in no situation may an applicant reply later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of this paragraph are available. See § 1.136(b) for extensions of time relating to proceedings pursuant to §§ 1.193(b), 1.194, 1.196 or 1.197; § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.550© for extensions of time in *ex parte* reexamination proceedings; § 1.956 for extensions of time in *inter partes* reexamination proceedings; and §1.645 for extensions of time in interference proceedings.

(3) A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in § 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission.

(b) When a reply cannot be filed within the time period set for such reply and the provisions of paragraph (a) of this section are not available, the period for reply will be extended only for sufficient cause and for a reasonable time specified. Any request for an extension of time under this paragraph must be filed on or before the day on which such reply is due, but the mere filing of such a request will not affect any extension under this paragraph. In no situation can any extension carry the date on which reply is due beyond the maximum time period set by statute. See § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.645 for extensions of time in interference proceedings; § 1.550© for extensions of time in *ex parte* reexamination proceedings; and § 1.956 for extensions of time in *inter partes* reexamination proceedings.

© If an applicant is notified in a "Notice of Allowability" that an application is otherwise in condition for allowance, the following time periods are not extendable if set in the "Notice of Allowability" or in an Office action having a mail date on or after the mail date of the "Notice of Allowability":

- (1) The period for submitting an oath or declaration in compliance with § 1.63; and

- (2) The period for submitting formal drawings set under § 1.85(c).

[47 Fed. Reg. 41277, Sept. 17, 1982, effective Oct. 1, 1982; 49 Fed. Reg. 555, Jan. 4, 1984, effective Apr. 1, 1984; 49 Fed. Reg. 48416, Dec. 12, 1984, effective Feb. 11, 1985; 54 Fed. Reg. 29551, July 13, 1989, effective Aug. 20, 1989; para. (a) revised, 58 Fed. Reg. 54504, Oct. 22, 1993, effective Jan. 3, 1994; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. © added, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a)(2) and (b) revised, 65 Fed. Reg. 76756, Dec. 7, 2000, effective Feb. 5, 2001]

- in response to Appeal Brief filed on 7 March, 2002, the Examiner's Answer was mailed on 22 May, 2002;
- therefore, Petitioner's Reply Brief (should he elect to file one) or a request under ¶(b) of 37 C.F.R. §1.136 for an extension of time within which to file a Reply Brief was due on or before Monday, 22 July, 2002;
- instead, on Tuesday, 23 July, 2002, Petitioner filed the instant petition and proffered with it his Reply Brief.

Because no extension of time was requested and obtained pursuant to 37 C.F.R. §1.136(b), the two month period for submission of a Reply Brief pursuant to 37 C.F.R. §1.193(b) expired at midnight 22 July, 2002.

When the Reply Brief was filed on 23 July, 2002, in the absence of a previously submitted request for an extension of time under the provisions of 37 C.F.R. §1.136(b), the Reply Brief was untimely.

ANALYSIS

Petitioner requests waiver under 37 C.F.R. §1.183 of the two- (2-) month time period for submission of the Reply Brief set forth in 37 C.F.R. §1.193(b). However, suspension of the rules under 37 C.F.R. §1.183 may be granted only in an "extraordinary situation, when justice requires."

Petitioner alleges that he was traveling due to family illness, however, there is no explanation why he could not have submitted a request and fee for an extension of time one day earlier in satisfaction of the regulations at 37 C.F. §1.136(b).⁴

Therefore, there is no adequate showing that the failure to file a request for an extension of time under 37 C.F.R. §1.136(b) to file the Reply Brief was caused or contributed to by circumstances beyond Petitioner's control.

⁴ In this regard, the elimination of fee extensions in the filing of reply briefs (and requests for oral hearings) was first proposed in 57 Fed. Reg. 43214 (September 21, 1992), *reprinted* at 1143 O.G. 33 (October 13, 1992). Initially, a one month time period was proposed for the filing of reply briefs and requests for oral hearings. However, after consideration of comments on the proposed rules the Notice of Miscellaneous Changes in Patent Practice announced that:

- the period was extended to two months (as adopted) to provide for counsel to communicate with, for example, foreign applicants; and
- "[e]xtensions of time for cause under § 1.136(b) will be available for those rare situations when an extension of time is necessary." 58 Fed. Reg. 54,504 at 54,508 (October 22, 1993), 1156 O.G. 54 at 57 (October 15, 1993).

The rules became effective 3 January, 1994, more than eight years before the time period in question. *Id.*

The showing of record is that Petitioner knew or should have known that adequate provisions for ensuring timely responses to Communications from the Patent and Trademark Office were required during the period in question.

The Office, where it has the power to do so, should not relax the requirements of established practice in order to save an applicant from the consequence of his delay.⁵

Thus, Petitioner failed to take such reasonable care against any other contributing factor, and waiver of the two month time period of 37 C.F.R. §1.193(b) in this situation is not justified pursuant to 37 C.F.R. §1.183.⁶

Accordingly, the petition under 37 C.F.R. §1.183 and §1.193(b) is dismissed.

ALTERNATIVE VENUE

Because there is no requirement for the timely submission of a Reply Brief, to avoid the abandonment of an application, the failure to timely submit such an amended reply brief has not resulted in the abandonment of this application.

Nonetheless, while the application is not abandoned, the untimeliness of Petitioner's actions make it appropriate to consider the matter apply the model of a remedy (if not the exact principles) in light of the regulations at 37 C.F.R. §1.137(b).⁷

Therefore, Petitioner may wish to consider filing a petition to the Commissioner requesting acceptance of the delayed reply brief as if timely filed on the grounds that the delay was unintentional.

A petition requesting acceptance of a delayed Reply Brief on the grounds of unintentional delay must be filed promptly and such petition must be accompanied by:

⁵ See, Ex Parte Sassin, 1906 Dec. Comm'r. Pat. 205, 206 (Comm'r Pat. 1906) and compare Ziegler v. Baxter v. Natta, 159 USPQ 378, 379 (Comm'r Pat. 1968) and Williams v. The Five Platters, Inc., 510 F.2d 963, 184 USPQ 744 (CCPA 1975). Thus, there is no adequate showing of "an extraordinary situation" in which "justice requires" suspension of the time period set forth in 37 C.F.R. 1.193(b). See, Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing papers). Circumstances resulting from petitioner's failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc., 195 USPQ 586, 588 (Comm'r Pats. 1977).

⁶ Delay resulting from the inadvertence or mistake of Petitioner does not warrant equitable tolling of the time period of 37 C.F.R. §1.193(b). Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable, due care and diligence. U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983); Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Even assuming *arguendo*, that clerical inadvertence or error caused or contributed to the delay in filing the Reply Brief, such is not a ground for requesting waiver of the regulations. See In re Kabushiki Kaisha Hitachi Seisakusho, 39 USPQ2d 1319, 1320 (Comm'r Pat. 1994).

⁷ The regulations at 37 C.F.R. §1.183 sets forth that waiver of the rules is "subject to such other requirements as may be imposed."

- (1) the amended reply brief (the requisite "reply");
- (2) the petition fee set forth in 37 C.F.R. §1.17(m); and
- (3) a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional."

Further correspondence with respect to this matter should be addressed as follows:

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By FAX: (703) 308-6916
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Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



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